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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,678	09/23/2005	Emil Wilding	31608-210847	1917
26694	7590	03/29/2009		
VENABLE LLP				
P.O. BOX 34385				
WASHINGTON, DC 20043-9998				
EXAMINER				
SZEKELY, PETER A				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
03/20/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,678

Applicant(s)

WILDING ET AL.

Examiner

Peter Szekely

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 12, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. A composition containing 75-95% polymer cannot contain 5-50% filler.
75+50=125. Furthermore, if 25% EVA were present, there would be no room for filler.

Clarification is required.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brehmer et al. 4,717,496, Goldberg 6,475,619 or British Shoe Machinery Ltd. WO 94/03211, in view of Gaku et al. 4,820,769, Oien 5,525,663 or Lees et al. 2006/121225, with Reith 4,939,036 as evidence.
6. The rejections are maintained in view of the "Response to Arguments" set forth below.

Response to Arguments

7. Applicant's arguments filed 3/3/09 have been fully considered but they are not persuasive. Applicants tested one of the compositions, that of Example 1 of Brehmer et

al. The reference shows 7 Examples. Applicants used PVC as a filler which is not present in any of applicants' formulations. Applicants' Example 8 shows PET, not PVC. Additionally, Brehmer et al. claims organic and inorganic fillers coated with plastics. Applicants have not shown that the compositions described by Brehmer et al. do not encompass applicants' invention. One of ordinary skill in the art would not have considered the disclosures of the references to be limited to their preferred embodiments or working examples. In re Fracalossi, 215 USPQ 569-570 (CCPA 1982). The examiner did not agree that the compositions are not the same. The anticipation rejection has been dropped because the references require a choice of materials between equivalents in order to arrive at applicants' composition. The examiner does not know what the MVR, the bonding activation, the viscosity or the tack is in each of compounds cited by the applied references and since the PTO cannot conduct tests, it is appropriate to shift the burden to applicants to do so. In re Best, 195 USPQ 430, 433-434 (CCPA 1977). None of the Examples in Table 2 contains a filler with a particle size outside the claimed parameters, so it is not possible to ascertain what the effect of particle size is. Reith proves that fillers having any particle size can be used in hot melt adhesive. Applicants' claims are open claims. Goldberg discloses poly-epsilon caprolactone and filler. Applicants did not prove that the presence of styrene-butadiene and 0.4% dispersant would interfere with applicants' invention. Applicants are claiming a composition. A fabric layer is not excluded by the claims. As far as the British Patent is concerned the viscosity shown is not melt viscosity and there is no mention of molecular weight in applicants' claims. "Shoe production" or "shoe stiffener" or

"reinforcing material for shoe production" is the intended use which has no patentable significance. The secondary references are cited only to show that the process of applicants' is known, since hot melt adhesives have been processed similarly before. The compositions of the hot melt adhesives taught by the secondary reference are irrelevant. The examiner understands the meaning of "yes" and the meaning of "no". However, the meaning of "yes/no", see Examples 2 and 8, eludes the examiner. The rejections stand.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekeley whose telephone number is (571) 272-1124. The examiner can normally be reached on 6:10 a.m.-4:40 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Peter Szekely/
Primary Examiner, Art Unit 1796

/P. S./
Primary Examiner, Art Unit 1796
3/18/09